

REMARKS

Claims 1-24 are pending. By this Amendment, no claims are cancelled, claims 1, 8, 9 16, 17, and 24 are amended, and new claims 25-30 are added. No new matter is introduced by the amendments or new claims.

In view of the following comments, Applicant respectfully requests favorable consideration and allowance of the claims.

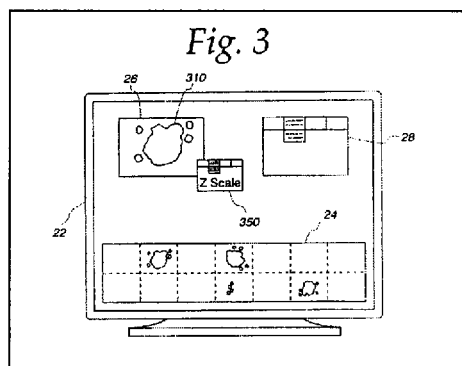
Claim Rejections Under 35 U.S.C. §103 Over Taubman, Bacus1, and Bacus2

Claims 1-6, 8-14, 17-22 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,709 to Taubman ("Taubman") in view of U.S. Patent No. 7,146,372 to Bacus et al. (identified by the Examiner as "Bacus1"), and further in view of U.S. Patent No. 6,226,392 to Bacus et al. (identified by the Examiner as "Bacus2"). Applicant respectfully requests withdrawal of the rejection, as a *prima facie* case of obviousness has not been established.

The Office Action indicates that Taubman discloses a method including (the user clicks on the region of interest because the user would like more information from the image." The office action cites Col. 21, Lines 53-56 which recites: "Using an input device such as a mouse, the user clicks on a region of the map, and the client generates a request for the region of interest. The request is sent to the server 502 (block 608)." This passage does not relate to "applying computerized image analysis operations for diagnostic purposes" as recited in claim 1 Bacus1 does not disclose or suggest these limitations either since it only discloses that a higher magnification image of a selected area is returned to the requestor. Merely providing a higher

magnification image does not entail “image analysis operations” thus this element of claim 1 is not disclosed or suggested by the combination of Taubman and Bacus1.

The Office Action admits that “Taubman and Bacus1 do not teach wherein the image analysis produces a non-image diagnostic result” but alleges that “Bacus2 teaches a method for acquiring and reconstructing magnified specimen of medical images wherein the analysis of the issue (sic) outputs a numerical score on the display window” citing col. 6, Lines 29-36. The office action continues “[t]hus the numerical score of Bacus2 reads on the claimed non-image diagnostic result.” Applicant respectfully traverses the assertion. The cited section recites “FIG. 3 is a view similar to FIG. 2 including the control window but also including a low magnification region from the slide showing regions marked by a histology grade or structure through automatic analysis of tissue and a high magnification window showing markings related to the grading or histology grade yielded by the automatic analysis of tissue in combination with a window showing a numerical score.” Fig 3 shows only a computer screen shot including a window that says “Z scale” depicted below.



The words “Z scale” do not appear in the written specification of Bacus2 nor is “Z scale” defined in Bacus2. Bacus2 does mention the term “Z score” several times. In statistics, a standard score is sometimes known as a z score. A standard score is a dimensionless quantity derived by subtracting the population mean from an individual raw score and then dividing the difference by the population standard deviation. Wikipedia. This has no bearing on a non-image diagnostic result as recited in the claims herein.

At Col. 11, lines 20-23 Bacus2 recites “remote users may be able to access the low magnification image as well as the high magnification image and move around within both images to make determinations as to the histological characteristics of the samples via Z scores.” At col. 12, lines 19-21 Bacus2 recites “The manner of doing these tests and of obtaining a Z score or grade is disclosed in the aforesaid patent application.” However, what “aforesaid patent application” is being referred to is not clear. None of this in Bacus2 is evidence of “at the first location, applying computerized image analysis operations to a region of the source medical image corresponding to the selected region of the decompressed medical image, the image analysis producing a non-image diagnostic result” as recited in claims 1, 9 and 17. Though “Z score” is a term used in statistics it is not defined in the cited prior art and no evidence has been presented that “Z score” as used in Bacus2 has any relation to a *diagnostic* result. At least this limitation of claim 1 is not disclosed or suggested by the cited prior art. Thus, the office action does not demonstrate a *prima facie* case of obviousness at least because no evidence has been presented that shows an enabling disclosure in the prior art of all the limitations recited in claim 1, 9 and 17.

Further, there is no disclosure or suggestion in the cited prior art that any image analysis done applied “to a region of the source medical image corresponding to the selected region of the decompressed medical image.” Thus, at least this additional limitation of the independent claims is not disclosed or suggested in the cited prior art and for this additional reason the office action does not make out a *prima facie* case of obviousness.

With respect to other features included in claims 1, 10, 19, and 28, and specific features of the claims depending therefrom, these are not commented on further, as they are presently moot given the above analysis, although Applicant does not acquiesce in the Examiner's position. Also, because the references do not teach all of the features of the claims, Applicant does not comment further here on the suitability of combining or modifying the cited references. Applicant respectfully requests withdrawal of the rejection.

Claims 2-8, 10-16, 18-24 and new claims 25-30 depend from independent claims 1, 9 or 17 and should be patentable for at least the same reasons as their respective independent claims.

Claim Rejections Under 35 U.S.C. §103 Over Taubman, Bacus1, Bacus2, and Burns

Claims 7, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taubman in view of Bacus I and Bacus II, and further in view of U.S. Patent No. 5,737,446 to Burns ("Burns"). Burns does not make up for the deficiencies of Taubman, Bacus I, and Bacus II discussed above with respect to claims 1, 9, and 17. Thus, a *prima facie* case of obviousness has not been established. Because the references do not teach all of the features of the claims, Applicant does not comment further here on the suitability of combining or modifying the cited references. Applicant respectfully requests withdrawal of the rejection.

New Claims

Claims 25-30 have been added. The cited references do not disclose all features of new claims 25-27 and their respective independent claims. As such, the Applicant respectfully requests favorable consideration and allowance of new claims 25-30.

Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Onderick', with a long horizontal flourish extending to the right.

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